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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

EXAMINER

SING, SIMON P

ART UNIT PAPER NUMBER

2614

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,152

Applicant(s)

UCHIDA ET AL.

Examiner

Simon Sing

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 4 and 5 is withdrawn in view of the newly discovered reference to Griesmer et al. Rejections based on the newly cited reference follow.

Claim Objections

2. Claim 1 is objected to because of the following informalities:

a) “the terminal unit”, recited in line 5, should be changed to “the origination terminal unit” for clarity since it lacks antecedence basis.

b) “origination country code” recited in lines 6 and 8, should be changed to “first country code” recited in line 12 since both meant the same code.

Appropriate correction is required.

3. Claim 2 is objected to because of the following informalities:

a) “the terminal unit”, recited in line 6, should be changed to “the origination terminal unit” for clarity since it lacks antecedence basis.

b) “origination country code” recited in lines 7 and 9, should be changed to “first country code” recited in line 13 since both meant the same code.

Appropriate correction is required.

4. Claims 4 and 5 are objected to because of the following informalities:

“the terminal unit”, recited in line 5, should be changed to “the origination terminal unit” for clarity since it lacks antecedence basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2 and 3 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting an essential step, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step in claim 2 is: linking “the first country code” to the language of the guidance information.

6. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting an essential step, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is: linking “the origination country code” to the language of the guidance information.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Caccuro et al. US 5,440,615.

Caccuro discloses a language selection method in figures 1- and 3, comprising:

storing originating country code in originating network (switchboard) 103 (column 2, lines 62-66; column 1, lines 51-59);

sending the originating country code to a voice messaging system 109 in the destination network 107 (column 2, line 62 to column 3, line 10; column 1, lines 51-59);

acquiring a telephone number of a caller terminal from network 103 via switch 109 (column 2, lines 52-55, 62-66; column 5, lines 21-27);

converting the telephone number into a first (originating) country code (column 5, lines 21-29);

selecting, from a database 303 in which the first country code is stored in association with guidance information (announcement) in a language identified by the first country code (column 5, lines 29-43); and

notifying the caller (originating) terminal unit via network 103 using the language selected (column 5, line 51 to column 6, line 11).

8. Claims 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fung et al. US 6,069,939.

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8.1 Regarding claim 7, Fung discloses a method for selecting a language in an international call based on a country code, comprising steps of:

storing an originating country code in a communication network (column 4, lines 51-58);

sending the originating country code through the communication network (column 4, lines 51-58);

acquiring the destination country code (column 4, lines 55-58; column 5, lines 27-34);

selecting prompts (guidance information) from a database (figure 9) based on the destination country code (column 5, lines 27-34);

notifying a called party's terminal with selected prompts (column 5, lines 27-34; column 7, line 65 to column 8, line 18).

8.2 Regarding claim 8, Fung discloses a method for selecting a language in an international call based on a country code, comprising steps of:

storing an originating country code in a communication network (switchboard) (column 4, lines 51-58);

sending the originating country code through the communication network (column 4, lines 51-58);

sending an originating telephone number and a destination telephone number with country codes (column 4, lines 51-58; column 6, lines 57-60; column 10, lines 30-38);

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acquiring the originating country code (column 4, lines 51-58, column 10, lines 30-38);

acquiring the destination telephone number (column 4, lines 55-58);

converting the destination telephone number into a destination country code (column 5, lines 27-34);

selecting prompts (guidance information) based on the destination country code (column 5, lines 27-34); and

notifying a called party's terminal with selected prompts (column 5, lines 27-34; column 7, line 65 to column 8, line 18).

8.3 Regarding claim 9, Fung discloses a method for selecting a language in an international call based on a country code, comprising steps of:

storing an originating country code in a communication network (column 4, lines 51-58);

sending the originating country code through the communication network (column 4, lines 51-58);

reading from a network element (such as network adjunct processor 60; figures 1, 8 and 9) an originating country code and destination code (column 4, lines 48-58; column 6, lines 57-60; column 10, lines 30-38);

acquiring the destination country code from an originating terminal (column 4, lines 55-58; column 5, lines 27-34);

selecting prompts (guidance information) from a database (figure 9) based on the destination country code (column 5, lines 27-34); and

notifying a called party's terminal with selected prompts (column 5, lines 27-34; column 7, line 65 to column 8, line 18).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caccuro et al. US 5,440,615 in view of Griesmer et al. US 5,878,124.

9.1 Regarding claims 1 and 5, Caccuro discloses a language selection system in figures 1 and 3, comprising:

acquisition means (controller 301) for acquiring a telephone number with an origination country code of a caller terminal from switchboard (communication network) 103 via switch 109 (column 2, lines 52-55, 62-66; column 5, lines 21-27);

converting means (controller 301) for converting the telephone number into a first (origination) country code (column 5, lines 27-29);

a database 303 (figure 4) in which the first country code is stored in association with guidance information (announcement) in a language identified by the first country code (column 5, lines 29-43);

selection means (controller 301) for selecting the guidance information (column 5, lines 29-43); and

notifying means (signal processing means 304) for notifying the caller terminal unit using the language selected (column 5, line 51 to column 6, line 11).

Caccuro teaches that the origination country code is stored in the switchboard, not in the caller (origination) terminal.

However, Griesmer discloses a universal telephone terminal 66 in figure 2, comprising a memory 202 for storing a calling number field 222 which comprised local (origination) country code 241 and local telephone number 242, and called number field 221 which comprised caller input (destination) country code 261 and (destination) telephone number 262 (column 4, lines 50-53; column 5, lines 43-46; column 6, lines 25-41), and the calling number field 222 and called number field 221 are sent to a destination server 50 when a call is placed (column 6, lines 21-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Caccuro's reference with the teaching of Griesmer so that the origination country code would have been stored in an origination telephone terminal instead of a network element, because a telephone terminal and a network element were both network nodes, and storing the origination country code in which node would have been a matter of design choice.

9.2 Regarding claim 3, Caccuro teaches a setting means (controller 301) for processing of the guidance information (column 5, line 21 to column 6, line 11).

10. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fung et al. US 6,069,939 view of Griesmer et al. US 5,878,124.

Fung discloses a system for selecting a language in an international call based on a country code, comprising steps of:

- storing an originating country code in a communication network (column 4, lines 51-58);

- sending the originating (first) country code and dialed (second) country code through the communication network (column 4, lines 51-58);

- acquiring the destination country code (column 4, lines 55-58; column 5, lines 27-34);

- converting a received call message to the second country code (column 4, lines 61-67; column 5, lines 1-14, 27-34);

- a database (figure 2) in which the second country code is stored in association with guidance information (column 5, lines 27-34);

- selecting prompts (guidance information) from the database (figure 9) based on the destination country code (column 5, lines 27-34);

notifying a called party's terminal with selected prompts (column 5, lines 27-34; column 7, line 65 to column 8, line 18).

Fung teaches that the origination (first) country code and the dialed (second) country code are stored in the switchboard, not in the caller (origination) terminal.

However, Griesmer discloses a universal telephone terminal 66 in figure 2, comprising a memory 202 for storing a calling number field 222 which comprised local (origination) country code 241 and local telephone number 242, and called number field 221 which comprised caller input (destination) country code 261 and (destination) telephone number 262 (column 4, lines 50-53; column 5, lines 43-46; column 6, lines 25-41), and the calling number field 222 and called number field 221 are sent to a destination server 50 when a call is placed (column 6, lines 21-50).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Fung's reference with the teaching of Griesmer so that country codes would have been stored in an origination telephone terminal instead of a network element, because a telephone terminal and a network element were both network nodes, and storing the country codes in which node would have been a matter of design choice.

Response to Arguments

11. Applicant's arguments filed on 03/01/2006 regarding claims 6-9 have been fully considered but they are not persuasive.

Applicants amended the claims to include storing an origination country code, but failed to point out where or what device the origination country code was stored. As mentioned in the previous rejection, communication networks in the quoted prior arts comprise storage devices for storing an origination country code.

12. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

13. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Simon Sing whose telephone number is 571-272-7545. The examiner can normally be reached on Monday - Friday from 8:30 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached at 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.



S. Sing

04/19/2006



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600